

I. REMARKS

Claims 1 and 8 to 11 are pending. No claims are amended, withdrawn, added, or canceled as a result of this response.

1. Claim Rejections under 35 U.S.C. § 101:

Claims 1 and 8 to 11 were rejected under 35 U.S.C. § 101, because the claimed invention allegedly “lacks a credible, substantial, specific or well-established utility.” Office Action at page 2. The Applicants respectfully traverse this rejection.

In addition to encoding proteins having a reasonable homology with Src homology 3 (SH3) domains, which are conserved protein domains having important roles in signal transduction, the specification also discloses that the nucleic acid molecules have promoter regions or partial promoter regions. Specification page 23, line 5 to page 30, line 6. In particular, the Applicants respectfully direct the Examiner’s attention to nucleotides 957 to 963 of SEQ ID NO: 1. This stretch of nucleotides TATAAA is the consensus sequence for a TATA box – a highly conserved sequence. *See, for example*, Benjamin Lewin, Genes VIII Chapter 9, (Prentice Hall 2003). About 50 bases upstream from the TATA box is another conserved sequence known as the CAAT box. *Id.* SEQ ID NO: 1 has this sequence as well. *See* nucleotides 897 to 901. In other words, the claimed nucleotide sequence can perform as a promoter. *See* specification pages 23 to 24. This is a credible, substantial, and well-established utility. Moreover, this utility is specific to SEQ ID NO: 1 and not generally applicable to any nucleic acid. The Applicants respectfully remind the Examiner that they need only establish a single utility to satisfy 35 U.S.C. § 101, and have done so in the present case.

The Applicants also respectfully remind the Examiner that the utilities asserted in the specification must be accepted as factually sound unless the Patent Office cites information that undermines the credibility of the assertion. *In re Brana*, 51 F.3d 1560, 1567, 34 U.S.P.Q.2d 1436, 1441 (Fed. Cir. 1995). Indeed, the Patent Office has recently accepted this utility as sufficient to pass similar claims to allowance. *See* Notice of Allowance in U.S. Pat. Appl. No. 09/815,264 mailed April 3, 2006.

In conclusion, because the Applicants have establish a credible, substantial, specific, and well-established utility, claims 1 and 8 to 11 satisfy 35 U.S.C. § 101. Therefore, the Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 101.

2. Claim Rejections under 35 U.S.C. § 112, first paragraph:

Claims 1 and 8 to 11 were rejected under 35 U.S.C. § 112, first paragraph because the claimed invention is allegedly “not supported by either a specific and substantial asserted utility or a well-established utility.” Office Action at page 12. The Applicants respectfully contend that this rejection has been overcome by the arguments set forth above with respect to the rejection under 35 U.S.C. § 101.

Specifically with respect to claims 8 to 11, the Examiner states that “the specification has not adequately taught one of skill in the art how to use nucleic acids which comprise a nucleic acid sequence which has 90% to less than 100% identity with SEQ ID NO: 1” and “one cannot determine a priori which sequence changes will effect functional activity and which will not.” *Id.* at pages 13, 14. The Examiner also rejected claims 8 to 11 under the written description requirement of 35 U.S.C. § 112, first paragraph. *Id.* at page 15. The Examiner states that “(w)hile nucleic acids consisting of SEQ ID NO: 1 meet the written description requirement, the

specification does provide adequate written description of the claimed genus of nucleic acids that share more than 90%, but less than 100% identity with SEQ ID NO: 1.” *Id.* at page 16. The Applicants respectfully disagree.

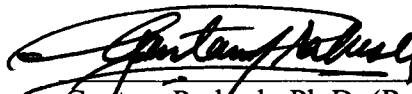
One of ordinary skill in the art would readily realize which nucleic acid sequences have 90% to less than 100% identity with SEQ ID NO: 1 and would be able to determine which sequence changes will effect functional activity and which will not. For example, if SEQ ID NO: 1 is used as a promoter, one of ordinary skill in the art could easily determine which nucleic acid sequences that have 90% to less than 100% identity with SEQ ID NO: 1 would work and which changes render the promoter ineffective. It is common knowledge to persons of ordinary skill in the art as to which and how many deletions, additions, or mutations enhance or diminish the effectiveness of promoters. Therefore, the Applicants respectfully submit that claims 1 and 8 to 11 fully satisfy both the enablement and written description requirements of 35 U.S.C. § 112, first paragraph, and respectfully request reconsideration and withdrawal of this rejection.

II. CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that the present application is now in condition for allowance, and respectfully request notice of such. The Examiner is encouraged to contact the undersigned at 202-942-5746 if any additional information is necessary for allowance.

Respectfully submitted,

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